

Applicants presented arguments with respect to the rejection under 35 U.S.C. § 101 substantially as indicated in this response. Examiner Nguyen agreed that the arguments overcome the rejection under 35 U.S.C. § 101. However, Examiner Nguyen also indicated that all pending claims, including those indicated as allowable, will be rejected as unpatentable over WO 96/11436 because the Examiner's supervisor believes that this reference prevents patentability of the pending claims. In a discussion of the merits of a possible new rejection based on the WO 96/11436 reference, Applicants took the position that this reference is merely a PCT publication corresponding to U.S. Patent No. 5,627, 549, to Park already distinguished on the record in this case. Therefore, a proper rejection based on the WO 96/11436 reference would have to address our arguments with respect to Park. Examiner Nguyen indicated that she would take these comments into consideration and carefully study the pending claims and WO 96/11436 reference and discuss this case with her supervisor before issuing another rejection.

Turning now to the rejection of Claims 43-57 and 60-63 under 35 USC 101, Applicants submit that these claims comply with 35 USC 101 because they recite computer implemented methods by which promotions are distributed to a vehicle. As discussed in the May 7th interview, the claims provide "a useful, concrete and tangible result," as required under US Law.¹ Moreover, the claims recite new and useful improvements of methods that are part of a class of inventions that have long been considered patentable, as evidenced by

¹ See State Street Bank & trust Co. v. Signature Financial Group Inc., 47 USPQ2d 1596, 1601 (CAFC 1998) (Holding "that the transformation of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price, constitutes a practical application of a mathematical algorithm, formula, or calculation, because it produces 'a useful, concrete and tangible result'" and thus satisfies 35 USC 101).

the great number of U.S. patents issued in this field, several of which being mentioned during the prosecution of this application. The usefulness of these methods have also been well established, especially in the field of distribution of promotions.

Consequently, 43-57 and 60-63 are believed to comply with 35 USC 101 and no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal allowance. An early and favorable action is therefore respectfully requested.



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Respectfully submitted,

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A handwritten signature in black ink, appearing to read "Edwin D. Garlepp".

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